

## **REMARKS**

This amendment is being submitted in response to the Final Office Action mailed May 16, 2008. Claims 1 and 5-6 are currently amended, claims 3, 7, and 12 are previously presented, and claims 2, 4, and 8-11 are canceled without prejudice. Thus, claims 1, 3, 5-7, and 12 are pending in this application. Applicants respectfully request consideration and allowance based on the amendments and remarks herein.

### **Acknowledgement of Applicants' Drawings:**

Applicants submitted drawing replacement sheets with the amendment filed March 20, 2008. The Office Action of May 16, 2008 neither objects to nor accepts these replacement sheets. Accordingly, Applicants respectfully request that the Examiner formally indicate the acceptance of the replacement sheets in the next Office Action.

### **Changes to the Claims:**

Claims 4 and 8 have been canceled without prejudice, and their limitations incorporated into independent claims 1 and 6, respectively. Claims 9-11 have been canceled for the sake of clarity. No new matter has been added by the claim amendments.

### **Rejection Under 35 U.S.C. § 103:**

Claims 1 and 3-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bird (U.S. Patent No. 4,080,103, hereafter Bird), in view of Thompson (U.S. Patent No. 3,301,255, hereafter Thompson), Richardson (U.S. Patent No. 5,752,506, hereafter Richardson), and Garoutte (U.S. Patent No. 5,222,489).

In this amendment, the limitations of claims 4 and 8, which recite a second water separator, have been incorporated into independent claims 1 and 6, respectively. Accordingly, this section presents remarks responsive to the portion of the Office Action that rejects now canceled claims 4, 10 and 11, which claims recited the second water separator.

On page 3 of the Office Action, the Examiner admits that Bird does not disclose a second water separator but contends that this feature is obvious on the grounds that mere duplication of parts involves only routine skill in the art. The Examiner cites to *St. Regis Paper Co. v. Bemis Co.* (193 USPQ 8) for this point of law. Applicants have reviewed the cited case and cannot find the proposition on which the Examiner relies. M.P.E.P. § 2144.04 (VI)(B) recites similar language, but cites to a different case, specifically *In re Harza*, 274 F.2d 669 (CCPA 1960). Accordingly, in the following, the holding in *In re Harza* is applied to the claims at issue in the instant application.

In *In re Harza*, the claim at issue was directed to a water stop to be placed in between masses of masonry material, with the water stop having a pair of opposite faces and a plurality of ribs integral with the faces. See *In re Harza* 274 F.2d at 670. The CCPA (Court of Customs and Patent Appeals) found the claim unpatentable because the only difference between the claimed invention and the prior art was that the claim recited “a plurality of ribs on each side of the web” where the prior art showed only a single rib on each side of the web. See *In re Harza* 274 F.2d at 671. Notably, the claim at issue in *In re Harza* merely recited a “plurality” of an item, in place of a single one of the same item in the reference, without reciting any functional difference in the locations of the respective ribs or in the operation of the respective ribs.

In contrast to the claim at issue the above case, claims 1 and 6 herein do not merely recite “a plurality of water separators” in place of a single water separator. Instead claim 1 recites “a second water separator . . . connected to the tube before the tapering passage” (emphasis added), whereas the first water separator is connected to the tube after the tapering passage. Similarly, claim 6 recites “wherein water which has condensed out of the gas before the compressed gas reaches the tapering passage is separated off in a second water separator” (emphasis added), whereas the first water separator separates off water from gas cooled in the tapering passage.

Applicants respectfully contend that the following hypothetical claim language helps illustrate the distinction between mere duplication and the subject matter actually recited in Applicants’ claims. If the prior art disclosed a single water separator located after the tapering passage, and if Applicants’ claims merely recited “a plurality of water separators located after the tapering passage”, the holding of *In re Harza* might be more applicable in the present case.

However, as described above, Applicants' claims recite features that are considerably more specific than reciting merely "a plurality of water separators."

Thus, Applicants' claims do not recite the "mere duplication" contemplated by *In re Harza*. Instead, the second water separator in claims 1 and 6 is deliberately placed in different location from the first water separator, specifically: prior to the tapering passage instead of after the tapering passage. Moreover, the operation of the second water separator differs from that the first water separator in that it removes water from the compressed gas before the gas goes through the tapering passage. No such variation in the location or function of the plurality of ribs is recited in the claims at issue in *In re Harza*. Accordingly, Applicants respectfully contend that the first and second water separators recited in claims 1 and 6 do not constitute "mere duplication" as contemplated by the holding in *In re Harza*. Since Applicants have not claimed a mere duplication of parts, Applicants respectfully contend that the requirement to show a new and unexpected result does not apply in this situation.

Based on the foregoing, Applicants contend that the "second water separator" limitations added to claims 1 and 6 in this amendment are not obvious over Bird under 35 U.S.C. § 103 (a). In addition to the distinctions discussed above, claim 1 recites still more features not disclosed in the prior art.

Claim 1 recites the language "wherein the tube contains a tapering passage after which a first water separator is "directly connected" (emphasis added). Neither Bird nor the secondary references disclose this feature. The specification of Bird is silent with respect to this feature. Moreover, the schematic illustration of Figure 3 of Bird suggests that the compressed air travels a significant distance through piping 53 prior to allowing precipitated water to be collected in water trap 54. Further, the secondary references also do not disclose this feature. Accordingly, the above-quoted feature of claim 1 is not disclosed by the prior art.

Based on the foregoing, claims 1 and 6 are patentable over the prior art under 35 U.S.C. § 103 (a). Claims 3, 5, and 12 depend from claim 1, claim 7 depends from claim 6, and the dependent claims inherit all the limitations of their respective independent claims. Moreover, the dependent claims recite further novel, nonobvious limitations not disclosed in the prior art. Accordingly, claims 1, 3, 5-7, and 12 are patentable over the prior art under 35 U.S.C. § 103 (a).

**Conclusion:**

In view of the foregoing, Applicants respectfully submit that the instant application is in condition for allowance. Early and favorable action is earnestly solicited. In the event there are any fees due and owing in connection with this matter, please charge same to our Deposit Account No. 11-0223.

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Respectfully submitted,

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